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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,993	10/12/2004	Winfried Stubbe	PAT-01026	8766
26922	7590	12/04/2007	EXAMINER	
BASF CORPORATION			EGWIM, KELECHI CHIDI	
Patent Department			ART UNIT	PAPER NUMBER
1609 BIDDLE AVENUE			1796	
MAIN BUILDING				
WYANDOTTE, MI 48192				
			NOTIFICATION DATE	DELIVERY MODE
			12/04/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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In re application of : DECISION ON
Stubbe et al. : PETITION
Serial No. 10/510,993 :
Filed: October 12, 2004 :
For: AQUEOUS DISPERSION OF INORGANIC :
NANOPARTICLES, METHOD FOR THE PRODUCTION: :
AND USE THEREOF :
:

This is a decision on the PETITION UNDER 37 CFR §1.181 requesting the restriction requirement in the office action mailed on January 17, 2007 be set aside as improper.

On January 17, 2007 a restriction requirement was mailed to applicants. In this requirement, the examiner held that the claims lack unity under PCT Rules 13.1 – 13.4 because the special technical feature linking the claims does not make a contribution over the art. Applicants traversed the restriction requirement in the response filed April 16, 2007. A final office action was mailed by the examiner on July 5, 2007, which made the restriction requirement final. The instant petition was then filed August 28, 2007. Accordingly, the instant petition is timely and will be decided on its merits.

DECISION

The instant application has been filed under 35 U.S.C. 371 as a national phase application of PCT/EP03/04645 and as such is subject to the unity requirements set out in PCT Rules 13.1 – 13.4 and 37 CFR 1.475, as well as the PCT Administrative Instructions, Annex B. The petitioner's request asserts that the reason given for restriction is improper and inadequate and petition for the restriction to be withdrawn. Petitioner further asserts the PCT rules do not require that patentability of any one or all of the claims must be established in order for the claims to have unity of invention. Thus, the Examiner's contention that there is no unity because claim 1 is allegedly anticipated or obvious is not a proper basis for finding lack of unity of invention. In the instant petition it is asserted that there is unity of invention among all of the groups since each group shares a common technical feature (i.e. an aqueous dispersion). The PCT Administrative Instructions, Annex B, Part 1 at (b) state that "the special technical features" common to all groupings of inventions shall be defined, as in PCT Rule 13.2, to mean,

"those technical features which each of the claimed inventions, considered as a whole, makes over the prior art." (Emphasis added)

In the instant case, the description and the claims set forth the special technical feature of an aqueous dispersion (see claim 1). However, the special technical feature of the aqueous

dispersion has been shown, at page 2 of the office action mailed January 17, 2007, to not make (be) a contribution over the prior art of US 6,599,631. Therefore, the examiner's finding that there is a lack of unity of invention between the groups as set forth in the restriction requirement was correct. The reason for such being that the groups constitute additional inventions not sharing a "special technical relationship" within the meaning of PCT Rule 13.2 since the identified "special technical feature" does not make a contribution over the prior art.

Accordingly, the petition is **DENIED**. The application remains in pending status awaiting a response to the final office action mailed July 5, 2007.

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